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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Docket Number (Optional)  
RF010906USNP

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number  
10/601118  
Filed  
6/23/2003First Named Inventor  
Robertson et al.Art Unit  
3686  
Examiner  
Robert (David) Rines

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

/Mark Nowotarski/

Signature

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

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Registration number if acting under 37 CFR 1.34. \_\_\_\_\_

July 27, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

## Remarks

The Applicant respectfully requests that the Pre Appeal Brief Board of Examiners reverse the Examiner's rejection of current claims 37 – 39 and 44 - 46 due to the following errors in the office action dated 4/28/09. Claim 37 is independent. All other claims depend upon claim 37. The Applicant asserts that if said errors were corrected, the claims would properly be held allowable.

### ***Errors in Rejection Under 35 USC 112 first paragraph***

The Examiner has erred in rejecting the claims under 35 USC 112, first paragraph, by failing to consider the Expert Declaration under 37 CFR 1.132 provided by Dr. Nathan Thompson. Said declaration shows that the Applicants were in full possession of the claimed invention at the time the application was filed.

*"The written description in the original disclosure as a whole does not have to describe the invention later claimed in haec verba, but such written description 'must . . . convey with reasonable clarity to those skilled in the art that . . . [appellant] was in possession of the invention . . . now claimed.' Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991)" (ex parte Wim J. Van Ooij, Appeal 2008-3517, emphasis added)*

Dr. Thompson is skilled in the art of the invention. He has stated that the Applicants' specification has conveyed to him with reasonable clarity that they were in full possession of the claimed "four or more target questions". Dr. Thompson's detailed answer to question 1 in the declaration, for example, points out that by providing the experimental results that yielded a minimum of 4 target questions, the Applicants demonstrated that they were in possession of more than 4 questions. Dr. Thompson then identified at least one additional question in the specification that was a suitable target question.

Furthermore, the MPEP 716.01 states

*Evidence traversing rejections, when timely presented, must be considered by the examiner whenever present. All entered affidavits, declarations, and other evidence traversing rejections are acknowledged and commented upon by the examiner in the next succeeding action. The extent of the commentary depends on the action taken by the examiner. Where an examiner holds that the evidence is sufficient to overcome the prima facie case, the comments should be consistent with the guidelines for statements of reasons for allowance. See MPEP § 1302.14. Where*

***the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient.*** General statements such as "the declaration lacks technical validity" or "the evidence is not commensurate with the scope of the claims" without an explanation supporting such findings are **insufficient**. (Emphasis added)

The Examiner erred by not referring to the Declaration at all. With respect to 35 USC 112, the Examiner is silent on the Declaration which is in clear error of this section of the MPEP.

The Examiner has further erred in rejecting the claims under 35 USC 112, first paragraph by asserting that open ended ranges (e.g. "four or more") are per se not enabled by any disclosure.

***"the Examiner must do more than point out that a claim is broader than a specific embodiment disclosed in the specification. See In re Rasmussen, 650 F.2d 1212, 1215 (CCPA 1981). The Examiner must provide some analysis that either: (1) considers factors such as the knowledge of one skilled in the art and the level of predictability in the field, Bilstad v. Wakalopulos, 386 F.3d 1116, 1125-26 (Fed. Cir. 2004), or (2) demonstrates that the specification distinguishes the prior art as inferior and touts the advantages of the specifically described embodiment. Tronzo v. Biomet, 156 F.3d 1154, 1159 (Fed. Cir. 1998) (claims not limited to conical cup implants found unsupported because specification distinguished prior art shapes as inferior and touted the advantage of the conical shape)".*** (Ex parte Costello, Appeal 2008-004534, emphasis added.)

The Examiner has not provided any analysis regarding the knowledge of one skilled in the art or a demonstration regarding the inferiority of the prior art. The Examiner, therefore, has failed to provide a *prima facie* case of lack of enablement.

The Examiner has still further erred in rejecting the claims under 35 USC 112, first paragraph by asserting that the limitation of "four or more target questions" is equivalent to an "infinite" number of target questions.

Claim 37 limits the number of target questions to a value less than the number of survey questions. The number of target questions, therefore, is bounded by the number of survey questions and is not infinite.

#### ***Errors in Rejection Under 35 USC 112, Second Paragraph***

The Examiner has erred in rejecting the claims under 35 USC 112, second paragraph by failing to provide a coherent reason for said rejection. The Examiner has stated:

*"It is unclear however the questions are selected to ensure the claimed 'significant increase'." (page 4 of the office action)*

For the purposes of this discussion, however, the Applicant will treat the Examiner's stated reason for rejection as

*"It is unclear, however, how the questions are selected...."*

Accepting this interpretation of the Examiner's rejection, however, the Examiner has still erred in rejecting the claims under 35 USC 112, second paragraph, by failing to consider the above referenced Expert Declaration provided by Dr. Nathan Thompson.

*"The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.' Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted)." (Ex parte Tichler, Appeal 2009-001045, emphasis added)*

Dr. Thompson is skilled in the art of the invention. He has indicated that he understands what is claimed when he reads the claim in light of the specification. See Dr. Thompson's detailed answer to question 1 wherein he states:

*"The statistical analysis process used by Robertson et al. produces the minimum number of target items (i.e. questions) from the candidate items that incrementally increase the multiple correlation with the dependent variable, automobile insurance claims."*

Persons of ordinary skill in the art understand what a "multiple correlation" analysis is, how it is performed and what its results are. The Examiner is referred to any number of standard texts for more background on the subject. Applicant is not required to include, in the application, information that is known in the art. In MPEP 2164.05(a), it states:

*The specification need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known to those skilled and already available to the public. In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and Lindemann Maschinenfabrik*

*GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).*

According to *In re Buchner*, it is preferable that the definition of "multiple correlation" analysis be excluded when it is understood by a person of ordinary skill in the art.

Accordingly, the examiner erred by not taking into consideration that which is known in the art and supported by a skilled artisan in the submitted Declaration.

#### ***Errors in Rejection under 35 USC 103***

The Examiner has erred in rejecting the claims under 35 USC 103 by failing to consider the claims as a whole.

*"In order to establish a prima facie case of obviousness, the Examiner must show that each and every limitation of the claim is described or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art.*

*In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988)." (Ex parte William Apps, Appeal 2009-002321, emphasis added).*

Claim 37 contains the newly added limitation:

*"wherein said step of analyzing said information to select said set of four or more target questions is carried out on a particular computer modified to calculate multiple correlations and the levels of confidence thereof."*

The Examiner has explicitly disregarded this limitation in his 103 rejection. He therefore has failed to show where this limitation is described or suggested by the prior art. Instead, the Examiner has merely cut and paste his earlier 103 rejection based on the prior version of claim 37 that did not have this limitation.

Specifically, the Examiner must consider "wherein" or "whereby" clauses when it states a condition that is material to the invention. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." Id. The "wherein" limitation of the claim describes how the analyzing step is carried out. The Examiner erred in not considering this limitation in his 103 analysis.

The Examiner has further erred in rejecting the claims under 35 USC 103 by failing to consider the above referenced Expert Declaration provided by Dr. Nathan Thompson or provide any reason why it is not persuasive.

***"All of the competent rebuttal evidence taken as a whole should be weighed against the evidence supporting the *prima facie* case. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).... If, after evaluating the evidence, the examiner is still not convinced that the claimed invention is patentable, the next Office action should include a statement to that effect and identify the reason(s) (MPEP 716.01(d), emphasis added)***

Dr. Thompson provided competent rebuttal evidence of adequate weight that numerous limitations of claims under examination are not found in the cited prior art. See Dr. Thompson's detailed answers to questions 2 (Lajunen does not select target questions based on a survey method), 3 (Lajunen does not measure any personality factors related to a person's tendency to report an accident), 4 (Lajunen does not give a survey to 200 or more subjects), 5 (Spolander does not ask any questions related to personality traits), 6 (Lajunen could not have controlled of age), 7 (Lajunen does not select target questions from his survey results, nor did he have any motivation to), 8 (The Applicants' selection of 4 questions was not a mere design choice), and 9 (The Applicants' four questions do not measure a single personality trait).

The Examiner has failed to explicitly address Dr. Thompson's observations and thus the obviousness rejection is dissipated. See *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

#### ***Examiner Recommendations***

The Examiner has provided recommendations on how to amend the claims to put them in condition for allowance. The Applicants appreciate the recommendations and would be willing to consider any Examiner amendments the Office would like to propose provided they properly took into account the expert declaration by Dr. Thompson.

Nonetheless, the Applicants respectfully request that the Board of Examiners reverse the Examiner's rejection and allow the instant claims.

/Mark Nowotarski/  
Agent for Applicant